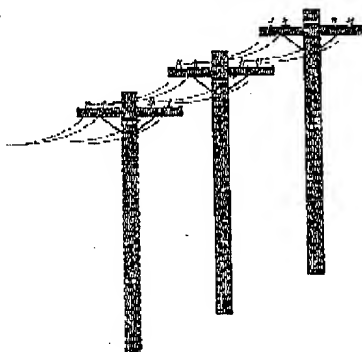
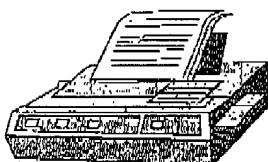


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T-815 P.002 F-834

SEP 24 2004

SD-6785/S-96,438  
Patent Application

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 09/886,175  
Applicants : David M. Teter, et al.  
Filed : June 20, 2001  
TC/A.U. : 1724  
Examiner : Ivars C. Cintins

For : INORGANIC ION SORBENTS AND METHODS FOR USING THE SAME

**Reply to Advisory Action**  
**And Request for Examiner's Rationale or Evidence Tending to Show Inherency**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia  
22313-1450

Sir:

**Introductory Comments**

In response to the Advisory Action mailed September 15, 2004, Applicants submit the following for inclusion in the record and to seek clarification of issues for appeal. No amendments are offered at this time. A complete listing of the claims begins on page 3 of this paper.

**Request for Examiner's Rationale or Evidence to Show Inherency**

The Examiner has finally rejected the claims under 35 U.S.C. 102(a) citing Sivavec '570 and Dawson et al. '831, and the Advisory Action states,

"[Applicants' request for reconsideration] does NOT place the application in condition for allowance because: both Sivavec and Dawson, et al. disclose contacting an aqueous stream containing the recited anionic contaminants with a composition containing the recited material (i.e. magnetite); and therefore, the results obtained in each of these references [Sivavec and Dawson, et al.] must inherently be the same as those obtained by Applicant in the recited process." (Advisory Action, p. 2, emphasis supplied.)

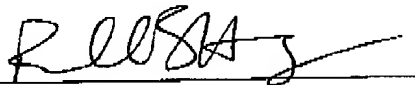
According to M.P.E.P. Section 2112, under heading IV, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of

SD-6785/S-96,438  
Patent Application

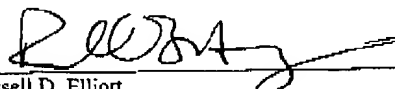
a result or characteristic; rather, an Examiner must provide rational or evidence tending to show inherency. For the purpose of clarifying issues for appeal, Applicants respectfully ask,

What is the **extrinsic evidence** (*In re Robertson*, 169 F.3d 743, 745, 29 USPQ2d 1949, 1950-51 [Fed. Cir. 1999]) or **basis in fact and/or technical reasoning** (*Ex Parte Levy*, 17 USPQ2d 1461, 1464 [Bd. Pat. App. & Inter. 1990]) on which the Examiner relies to support his conclusion of inherency, specifically, that Applicants' claimed limitation of "sorberent material that binds anionic species predominantly through the formation of surface complexes" is inherently a result or characteristic of Sivavec and Dawson, et al.?

Respectfully submitted,

Dated: 9/24/04Phone: (505) 844-5626  
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RUSSELL D. ELLIOTT  
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Albuquerque, NM 87185-0161CERTIFICATE OF TRANSMISSION (37 CFR 1.8(a))

I hereby certify that the foregoing paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on the date shown below.

Date: 9/24/04  
Russell D. Elliott